REMARKS/ARGUMENTS

Objections to the specification

The Examiner has objected to the presence of hyperlinks in the specification. As indicated in the "Amendments to the Specification" section, the hyperlinks have been removed.

Status of the claims

With entry of this amendment, claims 20, 23, 25, 28, and new claims 98 and 99 are pending. Claims 60, 63, 83, and 84 are canceled.

Support for the new claims and amendments can be found, *e.g.*, in paragraphs [0024], [0027], and [0214]- [0219] of U.S. Patent Publ. No. 20070269432. No new matter is added.

Elected invention

The Examiner has withdrawn claims 60, 63, 83, and 84 as allegedly not being drawn to the elected species. With this action, these claims are canceled.

Rejection under 35 USC § 102(b) - Matsumoto

The Examiner has rejected claims 20 and 25 as allegedly anticipated by Matsumoto *et al*. Matsumoto was available online November 6, 2004, and published in December, 2004.

The present application claims priority to U.S. Provisional Appl. 60/505,571, filed September 24, 2003, more than one year before Matsumoto. The International Application was filed September 2004. Thus, Matsumoto does not constitute prior art. Applicants respectfully request withdrawal of the rejection under 35 USC § 102(b).

Rejection under 35 USC § 102(e) - Goldsworthy

The Examiner has rejected claims 23 and 28 as allegedly anticipated by Goldsworthy *et al*. According to the Examiner, Goldsworthy teaches a method of screening for

inhibitors of BRC 456 (TOPK or PBK) comprising contacting a test agent with a BRC 456 polypeptide, detecting the biological activity of the BRC 456 polypeptide, selecting the compound that suppresses the biological activity of the BRC 456 polypeptide.

As amended, claims 23 and 28 are drawn to a method of screening for a compound for treating or preventing breast cancer comprising: contacting a compound with a BRC 456 polypeptide; detecting the kinase activity of the BRC 456 polypeptide; selecting the compound that suppresses the kinase activity of the BRC 456 polypeptide; and further selecting the compound that suppresses cell growth. Goldsworthy does not teach that the screening method includes selecting a compound that suppresses cell growth. Thus, the reference does not disclose every element of the claims.

Moreover, Goldsworthy does not constitute an enabling reference. As explained in the MPEP § 2121.01, the mere naming or description of the subject matter is insufficient for enablement of a prior art reference, if it cannot be produced without undue experimentation. Goldsworthy teaches that the expression of BRC 456 mRNA is upregulated in a number of cancer types, including breast cancer. Thus, according to Goldsworthy, BRC 456 may be useful as a tumor marker. The reference does not, however, provide any evidence that BRC 456 protein is overexpressed, or that the protein plays a role in tumorogenesis or tumor progression.

The present disclosure, on the other hand, demonstrates the causative effect of BRC 456 (or A7870) on breast cancer, including IDC. As explained in paragraphs [0217]-[0219], introduction of a BRC 456 inhibitor in breast cancer cell lines significantly reduced cell growth.

Goldsworthy does not disclose every element of the claims, or enable one of skill to screen for a compound that would effectively treat or prevent breast cancer. Thus, Goldsworthy does not anticipate the subject matter of claims 23 and 28. In view of the foregoing, Applicants respectfully request withdrawal of the rejection under 35 USC § 102(e).

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

Carol Johns

Carol P. Johns
Reg. No. 50,463

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
CPJ:cpj
61351562 v1